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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/698,793 | 10/31/2003 | Jeffrey M. Beraznik | 55487-10 | 1743 |

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| EXAMINER | |
|---|---|
| HANEY, RICHALE LEE | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3765 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/698,793 | BERAZNIK ET AL. | |
| | Examiner | Art Unit | |
| | Richale L. Haney | 3765 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

### *Response to Amendment*

The amendment of 9/18/2006 has been considered. Claim 1 and 10 are amended. Claims 1 – 20 are currently pending. The drawing objection of 3/17/2006 has been obviated.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 4– 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hocmuth (US 6,557,177). The device of Hochmuth discloses a glove, capable of being used while playing the sport of football, having a hand covering portion covering both the front and back of the wearer's hand, form fitting finger receptacles including a thumb receptacle (Figure 1) extending from the hand covering portion and in communication with the hand covering portion each having a front and back covering configured for covering the fingers of the wearer. The device of Hochmuth further comprises a unidirectional stiffener bendable towards the palm and rigid in the opposing direction (Column 4, lines 60 –65) enclosed between and inner layer (9) and the outer layer of the glove (Column 4, lines 1- 4). The stiffener is located in all five finger receptacles (Figure 1) adjacent a join (Column 2, lines 12 – 14) and has upper and lower (see

Figure 4, 22 and 19) interlocking sections (Column 2, lines 15 –18). The device of Hochmuth further discloses a stiffer having an upper interlocking ladder section (see top portion of the stiffener, figure 1) and a lower interlocking ladder section (see lower portion of the stiffener, figure 1), each of the upper and lower portions have a set of flexible side bars (23). The glove of Hochmuth has a wrist covering that wraps around the user's wrist and extends from the hand covering portion (Figure 1, 4 and 5; Column 3, lines 59 – 60).

3. Claims 10 –19 are rejected under 35 U.S.C. 102(b) as anticipated by Hochmuth (US 6,557,177) or, in the alternative, under 35 U.S.C. 103(a) as being an obvious modification. The device of Hochmuth discloses the claimed invention as applied to claims 1, 2 and 4– 8 above. The device of Hochmuth is capable of being worn and used in the manner claimed by the applicant. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the device of Hochmuth to play football and prevent hyperextension in the method claimed by the applicant.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmuth in view of Mulvaney (US 4,598,429). The device of Hochmuth substantially discloses the claimed invention but is lacking a tackified outer surface. The device of Mulvaney discloses a sports glove having a tacky material facing away from the users' palm (2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Hochmuth by incorporating a tacky portion as taught by Mulvaney in order to obtain improved gripping (Column 1, lines 15 –17). Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmuth in view of Rabbeth (US 5,970,521). The device of Hochmuth substantially discloses the claimed invention but is lacking a padded portion. The device of Rabbeth shows a glove having stiffening elements (37) and a pad (32; Column 4, lines 35 –38) that engages the stiffening elements. It would be obvious to one of ordinary skill in the art at the time the invention was made to use the device in the manner claimed by the applicant.

6. Applicant's arguments filed 9/18/2006 have been fully considered but they are not persuasive.

Applicant submits that Hochmuth is lacking a first and second set of flexible sidebars on upper and lower interlocking portions. When interpreted in the broadest reasonable sense Hochmuth meets the limitations claimed by applicant.

7. Applicant only requires one stiffener device, and does not claim a relationship between the upper and lower portions. The stiffener of Hochmuth has an upper and a

lower interlocking portion; each portion has a set of flexible sidebars. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., upper and lower interlocking later structures snapped together (in a specific plane)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to the method of claim 10, limitations, which are drawn to a method of using a claimed apparatus, are interpreted to be met by the apparatus itself. The device of Hochmuth is inherently capable of performing the method claimed. In the instant application, one would be motivated to use the claimed apparatus by the method claimed in order to prevent injury during sporting events, including football.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fleischmann (US 7,143,447) discloses an upper and lower interlocking ladder finger stiffener.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richale L. Haney whose telephone number is 571-272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Haney

Examiner
Art Unit 3765

RLH

KATHERINE MORAN
PRIMARY EXAMINER